

REMARKS

This application is amended in a manner to place it in condition for allowance at the time of the next Official Action.

Status of the Claims

Claim 11 is amended to delete the compound N-(1-methyl-2-(3,4-dimethoxy-phenyl)-ethyl)-hydroxylamine.

Claim 15 is amended to add N-ethyl-1-(3-hydroxyphenyl)-2-hydroxylaminoethane to the excluded compounds.

No new matter has been added by this amendment. As cited in MPEP 2173.05(i):

If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977).

In the instant case, the compound deleted from claim 11 was explicitly positively recited in the specification at line 27 of page 7, and in the case of the excluded compound of claim 15, this compound was implicitly positively recited by the general formula (I) on pages 5 and 6, e.g., when n=0, R¹=H, R²=OH, R³=H, R⁴=H, R⁵=ethyl and R⁶=H.

Claims 11, 13-17 remain in this application.

Claim Rejections-35 USC §102

Claim 11 was rejected under 35 U.S.C. §102(b) as being anticipated by MORGAN et al. *Tetrahedron*, 1975 (MORGAN). This rejection is respectfully traversed for the reasons below.

MORGAN was offered for teaching N-(1-methyl-2-(3,4-dimethoxy-phenyl)-ethyl)-hydroxylamine, which is no longer recited in Claim 11.

Therefore, MORGAN does not anticipate, and withdrawal of the rejection is respectfully requested.

Claim 15 was rejected under 35 U.S.C. §102(b) as being anticipated by KORTING et al. Arzneimittel-forschung, 1954 (KORTING). This rejection is respectfully traversed for the reasons below.

KORTING was offered for teaching N-ethyl-1-(3-hydroxyphenyl)-2-hydroxylaminoethane, which is now excluded from Claim 15.

Therefore, KORTING does not anticipate, and withdrawal of the rejection is respectfully requested.

Claim Rejections-35 USC §103

Claims 11 and 13 and claims 11 and 14 were separately rejected under 35 U.S.C. §103(a) as being unpatentable over MORGAN. This rejection is respectfully traversed for the reasons below.

For reasons discussed above MORGAN fails to disclose the claimed compounds. Moreover, MORGAN fails to suggest either the compounds or their use in pharmaceutical compositions.

The position of the Official Action was that MORGAN discloses the derivatives therein described "as being studied for their neuropharmacological effects".

Presumably, this is based on the vague statement found in the introduction of MORGAN: "The N-hydroxy derivative has been prepared and screened for behavioural and neuropharmacological effects".

However, no pharmacological data are reported in the paper proving this statement. Reference 7 cited in MORGAN supports the above statement (E. R. Shepard et al., J Am. Chem. Soc. 1952, 4611) is concerned with a completely different class of compounds from the structural and pharmacological point of view, namely 3-methylisoquinolines endowed with cardiovascular (coronary dilator) activities.

Therefore, MORGAN fails to render obvious claims 11, 13 and 14, and withdrawal of the rejection is respectfully requested.

Claims 15 and 16 and claims 15 and 17 were separately rejected under 35 U.S.C. §103(a) as being unpatentable over KORTING. This rejection is respectfully traversed for the reasons below.

For reasons discussed above KORTING fails to disclose the claimed compounds. KORTING further fails to suggest either the compounds or their use in pharmaceutical compositions.

The position of the Official Action was that KORTING discusses uses of the compounds therein described "in a way that affects a component of the nervous system".

However, KORTING is concerned with pharmacological activities, and particularly pilomotor activity, which are totally unrelated to the specific therapeutic indications claimed in the instant application. The compounds of the claimed invention are disaggregating agents and they are endowed with anti-aggregating activity towards beta-amyloid proteins. They are therefore useful for the treatment of neurodegenerative diseases caused by the build up of these proteins.

The skilled artisan, on the basis of KORTING would not have concluded that the compounds of the invention would be endowed with disaggregating and/or anti-aggregating activities of beta-amyloid proteins.

Therefore, KORTING fails to render obvious claims 15, 16 and 17, and withdrawal of the rejection is respectfully requested.

Conclusion

In view of the amendment to the claims and the foregoing remarks this application is believed to be in condition for allowance at the time of the next Official Action. Allowance and passage to issue on that basis is respectfully requested.

Should there be any matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized in this, concurrent, and future submissions, to charge any deficiency or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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